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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,888	07/29/2003	David W. Bartley	GRLK0078	5567

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EXAMINER	
OH, TAYLOR V	

ART UNIT	PAPER NUMBER
1625	

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/629,888	BARTLEY ET AL.	
	Examiner	Art Unit	
	Taylor Victor Oh	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 April 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15,17-32,34 and 35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15, 17-32, and 34-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

8.00

Final Rejection

The Status of Claims

Claims 1-15, 17-32, and 34-35 are pending.

Claims 1-15, 17-32, and 34-35 have been rejected.

Claim Rejections-35 USC 112

1. Applicants' argument filed 4/11/05 have been fully considered but they are not persuasive.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of Claim 11 has been withdrawn due to the modification made in the amendment. However, there are still some issues to be resolved in claims 1, 15, 19, 27, 32, and 34.

Claims 1-15, 19-32, and 34-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 15, 19, , 32 ,and 34, the term " tetrabromobenzoate ester-containing product " is recited. The expression is vague and indefinite because the

phrase "tetrabromobenzoate ester-containing" would mean that there are other components present in the product besides the tetrabromobenzoate ester ; there is uncertainty as to what other compounds are present in the product. Therefore, an appropriate correction is required.

In claims 7 and 27, the phrase " general formula" is recited. This is vague and indefinite because the specification does not explain what is meant by the term" general " in the formula and how general the formula can be . Therefore, an appropriate correction is required.

Claim Rejections-35 USC 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The rejection of Claims 16-18 and 33-35 under 35 U.S.C. 102(b) as being anticipated clearly by Hill et al (U.S. 5,637, 757) has been withdrawn due to the cancellation of the claims and modification of the claims.

The rejection of Claims 19-32 under 35 U.S.C. 102(b) as being anticipated clearly by Hill et al (U.S. 5,637, 757) has been maintained with reason for the record on 1/12/05.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The rejection of Claims 1-35 under 35 U.S.C. 103(a) as being unpatentable over Hill et al (U.S. 5,637, 757) in view of Finley (U.S. 4,375,551) has been maintained.

The rejection of Claims 1-35 under 35 U.S.C. 103(a) as being unpatentable over Hill et al (U.S. 5,637, 757) in view of Finley (U.S. 4,375,551) has been maintained with reason for the record on 1/12/05.

Applicants' Argument

2. Applicants argue the following issues:

a. Hill does not disclose adding the starting materials to a glass vessel already heated to a decarboxylation favorable temperature;

b. Hill does not disclose adding the reactants to a vessel already containing tetrabromobenzoate ester as in claims 19-32, 34, and 35;

c. Both Hill et al and Finley disclose adding the materials to a vessel and then heating the vessel and reactants unlike the current invention which teaches feeding the reactants to a reactor having a temperature that favors decarboxylation.

The applicants' argument have been noted, but these arguments are not persuasive.

First, with respect to the first ,second, and third arguments, the Examiner has noted applicants' argument. However, with respect to the pre-heated reactor, it is directed to the optimization of the reaction process, not the novelty of the process ; it is well-known in the secondary Finley art that it is desirable to heat the reaction mixture to accelerate the reaction in comparison with no external application of heat (see col. 3, lines 27-30). Moreover, regarding to the process involved from the half-ester to the full ester, it is well established that batch and continuous processes are not patentably distinct. See , e.g. , In re Dinot , 319 f. 2d 188, 138 USPQ 248 (C.C.P.A. 1963). Therefore, it would have been obvious to the skilled artisan in the art to be motivated to pre-heat the reaction mixture in the reactor to the favorable decarboxylation temperature because the skilled artisan in the art would expect such a modification to be successful and such an operation is well-known in the art to the skilled artisan as the guidance shown (see col. 3, lines 27-30).

Furthermore, the secondary Finley art does disclose that it is possible to recycle the solution separated from the solution containing diester during the process (see col. 3 ,lines 55-57). Thus, the prior art are still relevant to the issue of the invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6/21/05

Cecilia J. Tsang
Supervisory Patent Examiner
Technology Center 1600